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PATENT

Application No. 09/700,391

Attorney Docket No. 02481.1716-00



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jürgen BONGS et al.

Serial No.: 09/700,391

Filed: November 14, 2000

For: METHOD FOR CATALYZING COMPLEX
REACTIONS OF LARGE MOLECULES
USING ENZYMES WHICH ARE BONDED TO
A POLYMER SUPPORT

Group Art Unit: 1651

Examiner: Marx, Irene

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action dated March 27, 2002, the Office required restriction under 35 U.S.C.

§§ 121 and 372 to one of the following groups of claims:

Group I: Claims 11, drawn to a process for catalysis using a polymeric support;

Group II: Claim 12-21, drawn to a process of enzymatic extraction of biomolecules
using a polymeric support.

The restriction requirement is respectfully traversed. However, to be fully
responsive to the action, Applicants elect, with traverse, the invention of Group II.

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The Examiner's attention is directed to PCT Rule 13.2 which sets for the circumstances in which the requirement of unity of invention is considered fulfilled:

PCT RULE 13.2:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicants respectfully submit that all the claims of the application are so linked as to form a single general inventive concept as required by PCT Rules. Group I and Group II contain at least one of the same technical features in that all of the claims involve the use of a polymeric support system to support a reaction. This polymeric support system defines a contribution which all of the claims make over the prior art.

Further, The Examiner's attention is directed to M.P.E.P. § 803, which sets forth criteria for the Examiner to follow in making a proper requirement for restriction. The following passage is pertinent to the issue herein.

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see M.P.E.P. §§ 802.01, 806.04, 808.01) or distinct as claimed (see M.P.E.P. §§ 806.05-806.05(I)); and

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- (2) There must be a serious burden on the Examiner if restriction is not required (see M.P.E.P. §§ 803.02, 806.04(a)-(j), 808.01, and 808.02).

In the present case, the Examiner has not shown that there would be a serious burden to examine Groups I-II together, despite the assertion that the inventions are distinct. Applicants respectfully submit that a search of Group II which discloses the use of a polymeric support would necessarily require a search of Group I which discloses the use of a polymeric support. Thus, a search for the subject matter in all groups would not be burdensome.

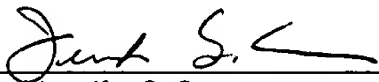
In view of the foregoing remarks, Applicants believe the restriction requirement to be in error and respectfully request that the requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 26, 2002

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